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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/545,367	04/07/00	PIECHNICK	J 6125/54125

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MM91/1107

EXAMINER

NGUYEN, T

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 11/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
**09/545,367**

Applicant(s)  
**Piechnick**

Examiner  
**Tuyen T. Nguyen**

Art Unit  
**2832**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 9, applicant should clarify which “axially spaced walls” are intended.

Claims 2-9 inherit the defects of the parent claim.

Regarding claim 2, the term “substantially” is a relative term.

Regarding claim 9, applicant should clarify what is intended by the first body portion forming a tubular portion extending away from the first body portion.

Regarding claims 10 and 13, the phrase “adapted to” is unclear because it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138, 33 CCPA 879 (1946). MPEP 706.03(c).

Regarding claim 13, applicant should clarify the specific structure of the recess arrangement.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5, 9, 15 and 16, as best understood in view of the rejections under 35 U.S.C. second paragraph, are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al. [US 4,000,483].

Cook et al. discloses a transformer comprising:

- a first bobbin member [35] including:
  - a first body portion [36] defining a first hollow region [37];
  - axially spaced first walls [39, 40] extending radially away from the first hollow portion;
- a second bobbin member [20] including:
  - a second body portion [22] defining a second hollow region [23];
  - axially spaced second walls [25, 28] extending radially away from the second hollow portion, and a flange [30] on one of the second axially spaced walls and extending away from the other second axial spaced wall of the second bobbin member; and wherein the first bobbin member is disposed adjacent to the second bobbin member and is partially enclosed by the flange;

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- primary and secondary windings [21, 42] wound about the first and second hollow body portions and about a common axis [figure 1]; and
- a laminated core [10] disposed within the first and second hollow regions.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Estrov [US 5,010,314].

Cook et al. discloses the instant claimed invention except for two flange portions being perpendicular with each other.

Estrov discloses a bobbin structure having at least one flange including two portions being perpendicular with each other [see figure 1].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the bobbin design of Estrov in Cook et al. for the purpose of protecting the core structure.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Dobberstein [US 4,549,130].

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Cook et al. discloses the instant claimed invention except for a conductive shielding used in the bobbin structure.

Dobberstein discloses a bobbin structure having a conductive shielding member [123].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use conductive shielding between the bobbin members of Cook et al., as suggested by Dobberstein, for the purpose of reducing interference.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Eng, Jr. et al. [US 4,857,878].

Cook et al. discloses the instant claimed invention except for the bobbin including pins.

Eng, Jr. et al. discloses a bobbin structure including pins [110].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include pins in the bobbin structure of Cook et al., as suggested by Eng, Jr. et al., for the purpose of providing terminals for the windings.

9. Claims 7-8 and 10-13, as best understood in view of the rejections under 35 U.S.C. second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Equi et al. [US 4,939,623]

Cook et al. discloses the instant claimed invention [see above] except for the bobbin including a mounting structure for receiving a printed circuit board.

Equi et al. discloses a bobbin having a mounting structure [see figure 3] for mounting a printed circuit board [26].

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to a mounting structure in the bobbin structure of Cook et al., as suggested by Equi et al., for the purpose of facilitating mounting.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

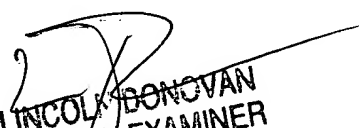
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Gellner, can be reached at (703)308-1721. The fax number for this Group is (703)308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

TTN TTN

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November 5, 2001

  
LINCOLN DONOVAN  
PRIMARY EXAMINER  
GROUP 2100